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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WRIGHT, ANDREW D

ART UNIT PAPER NUMBER

3617

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,525

Applicant(s)

BROELEMANN, ROLF

Examiner

Andrew Wright

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/18/03</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

1. The drawings are objected to because the figure should be labeled "Fig. 1".
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the front side with a symbol and the rear side opaquely covering the plastic sheet while not covering the symbol (claim 1), the printing applied on a front side of the plastic sheet (claims 3 and 11), and the entire sheet covered by transparent plastic injection molding material (claim 9) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
3. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the plastic injection molding material as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d).
4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

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consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities. The reference character "24" is used with the "circumferential border" in the specification (page 5) but appears to be associated with the emitted light in the figure. Clarification is requested. Appropriate correction is required.

Claim Objections

6. Claim 7 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must be written in the alternative only. See MPEP § 608.01(n). Accordingly, claims 7 and 8 have not been further treated on the merits.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

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which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 recites "formed by injecting transparent plastic injection molding material from behind against the plastic sheet". The specification describes that the injection molding material is opaque (page 5). The specification does not describe how to make and/or use the invention where the injection molding material is transparent.

Claims 2-8 depend from claim 1.

9. Claim 9 recites that the rear side is formed by injecting transparent plastic material against the plastic sheet over the entire surface thereof. This is not adequately described. The specification describes that the injection material covers the rear side of the plastic sheet except for the symbol fields (page 5). The specification does not describe how to make and/or use the invention where the injection material covers the entire surface as recited in claim 9. The specification describes that the injection molding material is opaque (page 5). The specification does not describe how to make and/or use the invention where the injection molding material is transparent. Claims 10-13 depend from claim 9.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 3-6 and 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Claim 3 recites the limitation "the front side" in line 2. There is insufficient antecedent basis for this limitation in the claim. A front side has already been recited. It is unclear if this recitation refers to the already recited front side of the cover element or to a different front side of the plastic sheet. Claims 4-6 depend from claim 3. Claim 11 has a similar recitation. Claims 12 and 13 depend from claim 11.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Bailey et al. (US 4,848,017). Bailey shows a sign (10). Cover element (14) has multiple sides including a front side (16) and a rear side (38a-e). Front side (16) is a translucent, colored, plastic sheet (column 3, lines 16-18) with a symbol (51). A translucent sheet constitutes a transparent sheet with a translucent color. Rear side (38a-e) has surfaces that face away from the front side. Rear side (38a-e) is opaque plastic that covers portions of the plastic sheet (16) while not covering the symbol (51).

15. It is noted that the claim 1 recitation "formed by injecting transparent plastic injection molding material from behind against the plastic sheet" is a product-by-process recitation. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Even though product-by-process claims

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are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. See MPEP 2113.

16. Regarding claim 2, the symbol (51) is painted on the plastic sheet (16). Painting is a form of printing.

17. Regarding claim 3, the symbol is painted on the plastic sheet (16). Painting necessarily occurs on one side of the sheet. The side that it is painted on constitutes a front side.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al. (US 4,848,017). Bailey discloses that the symbol (51) is painted on the plastic sheet (16). Bailey does not specify a single color or multiple colors. It is within the range of knowledge of the skilled artisan to use a single color of paint for the symbol or to use multiple colors of paint for the symbol. The choice to use a single or multiple colors would constitute an aesthetic design choice, the motivation of which would be to optimize design parameters such as appearance, and cost and availability of specific paints. Therefore it would have been obvious to one having ordinary skill in the art at

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the time the invention was made to modify Bailey by using either a single color or multiple colors for the symbol.

20. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al. (US 4,848,017) in view of Deyak et al. (US 6,641,880). Bailey teaches the use of a fluorescent bulb (18) for the light source. Deyak teaches that a light box can have an LED source instead of a fluorescent source (column 1, lines 40-43). Both types of light source are well known and common in the art. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bailey by using an LED instead of a fluorescent bulb. The motivation would be to optimize design parameters such as cost, weight, and lighting characteristics of the light source. Marsh (US 6,471,388) teaches that commonly available LED's are monochromatic. Therefore the use of a commonly available LED in the Bailey invention provides a monochromatic light source that back-illuminates the symbol.

Conclusion

21. Any inquiry concerning this communication should be directed to examiner Andrew D. Wright at telephone number (703) 308-6841. The examiner can normally be reached Monday-Friday from 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano, can be reached at (703) 308-0230. The fax number for official communications is 703-872-9306. The fax number directly to the examiner for unofficial communications is 703-746-3548.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew D. Wright
Patent Examiner
Art Unit 3617

AW 9/8/04
ANDREW D. WRIGHT
PRIMARY EXAMINER